

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Breitenbach, A.
Serial No.: **10/517,157**
Filed: December 6, 2004
Title: **DEVICE FOR THE TRANSDERMAL ADMINISTRATION OF A
ROTIGOTINE BASE**
Group Art Unit: 4131
Examiner: R.E. Welter
Confirmation No.: 5686
Docket No.: **6102-000074/US/NP**
Client Ref.: P/Brt/V/13/02

SUBMITTED ELECTRONICALLY VIA EFS-WEB

May 27, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION DATED APRIL 24, 2008

This paper is responsive to the Office Action dated April 24, 2008 in the above referenced application, in which a shortened statutory period of one (1) month was set for reply. This response is timely and no fee for extension of time is believed payable.

Applicant takes the opportunity to submit herein a supplemental Preliminary Amendment. No change in total number of claims, number of independent claims or multiple dependency arises as a result of this amendment and no excess claim fees are believed payable.

If any fee is nonetheless found to be payable by Applicant in respect of the present submission, authorization is hereby provided to charge such fee to Deposit Account No. 08-0750.

RESPONSE TO RESTRICTION REQUIREMENT

Claims 12–28 are pending in the present application. By the present Action, Applicant

is required under 35 U.S.C. §§121 and 372 to restrict the application to one of the following groups:

- I. Claims 12–16
- II. Claims 17–19
- III. Claims 20–25
- IV. Claims 26–28

Applicant provisionally elects with traverse the invention of Group I, embodied in Claims 12–16 which are drawn to a matrix for transdermal administering of rotigotine.

Applicant traverses the present restriction requirement on the grounds that:

- (a) Groups I–III, although patentably distinct, do indeed comply with the unity of invention requirement of PCT Rule 13, at least for the reasons set forth below; and
- (b) Group IV, although patentably distinct, is sufficiently closely related to Groups I–III to form part of the same general inventive concept. Examination of Group IV together with Groups I–III will not pose an undue search or examination burden on the Examiner.

The Examiner states that the inventions listed as Groups I–IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they allegedly lack the same or corresponding special technical features. The Examiner asserts that the common technical feature is allegedly taught by “Lauterbach *et al.*”. Applicant assumes the Examiner is referring to U.S. Patent Application Publication No. 2003/0026830 or 2003/0027793 of Lauterbach *et al.* as cited in Applicant’s Information Disclosure Statement dated December 6, 2004. The common technical feature allegedly taught by Lauterbach *et al.* is “a matrix for transdermal administering of rotigotine.”

Applicant does not admit that Lauterbach *et al.* represents prior art to the present invention. In any case, all claims of Groups I–III share as common technical features all limitations of Claim 12 or alternatively of Claim 13, not merely the general feature of “a matrix for transdermal administering of rotigotine” as proposed by the Examiner.

Under MPEP 1850(II), unity of invention has to be considered only in relation to

independent claims, and not to dependent claims. Under PCT Rule 6.4, a dependent claim is any claim which includes all the features of one or more other claims. Because all of the claims in Groups II and III (Claims 17–25) include all the features of Claims 12 or 13, they should be considered “dependent” from Claims 12 and 13 at least for purposes of unity of invention. Therefore, Applicant submits that Groups II and III have unity of invention with Group I and that the restriction requirement is improper at least with respect to these groups and should be withdrawn.

Applicant notes that, even if restriction between Group IV and Groups I–III is maintained in spite of Applicant’s traverse herein, process claims that depend from or otherwise require all limitations of an allowable product claim, or are amended to depend from or otherwise require all limitations of an allowable product claim, will be considered for rejoinder. Applicant may consider making such amendment during prosecution but elects not to introduce such amendment at this stage.

For reasons set forth above, Applicant respectfully requests withdrawal of the present restriction requirement. In further support of this request, Applicant notes that no unity of invention rejection was made in the August 12, 2004 International Preliminary Examination Report of PCT Application No. PCT/EP2003/014902, of which the present application represents the national stage under 35 U.S.C. §371.

SUPPLEMENTAL PRELIMINARY AMENDMENT UNDER 37 C.F.R. §1.115

(AMENDMENT B)

Prior to substantive examination, entry of the following amendment is respectfully requested.

Amendments IN THE CLAIMS are reflected in the listing of claims which begins on page 4 of this paper.

REMARKS on the present amendment begin on page 7 of this paper.